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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/693,690

10/20/2000

Kia Silverbrook

NPA064US

8647

24011

7590

05/23/2005

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

PORTER, RACHEL L

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/693,690

Applicant(s)

SILVERBROOK ET AL.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2004 and 05 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/18/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the Applicant's responses filed 9/3/04 and 2/2/05. Claims 1-44 are pending. The IDS filed 1/18/05 has been entered and considered.

***Specification***

2. The objection to the disclosure is hereby withdrawn due to the amendment filed 9/3/04.

3. The objection to the title of the invention is hereby withdrawn due to the amendment filed 9/3/04.

***Oath/Declaration***

4. The objection to the oath/declaration is hereby withdrawn due to the new oath/declaration filed 9/3/04.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, the function(s) carried out by the "sensing device" in claim 1 is/are unclear to the Examiner. In particular, it is unclear whether the "sensing device" is receiving/sensing the indicating data (as its name suggests) or if it is generating the indicating data. Claims 2-3 inherit the deficiencies claim 1, and are therefore also rejected.

Claim 4 recites similar language to claim 1, and is therefore rejected for the same reasons provided in the rejection of claim 1.

Similarly the function(s) carried out by the "sensing device" in claim 5 is/are unclear to the Examiner. The present claim recites that the sensing device provides the computer system with data regarding the identity of a customer, a form and the position of the device relative to the form in the claim. However, the claim later recites that the sensing device is generating data regarding the identity of the form and its position. Consequently, it is unclear whether the "sensing device" is receiving/sensing the data (as its name suggests) or if it is generating the data.

Claims 6-26 inherit the deficiencies of their respective independent claims, and are therefore also rejected.

Claim 27 further recites "a printer configured to...". The current claim language is vague and indefinite because it does not provide a positive recitation of the printer's functions. In other words, it is unclear whether the recited printer actually performs the step(s) recited in the claim.

It is noted that the Applicant has amended the claim language to recite "configured to". However, language such as "operable/operative to," "adapted to" and

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"capable of" do not provide a positive recitation of a component's functionality.

Therefore, it remains unclear to the Examiner whether the claimed element actually performs the functions following the phrase "configured to..." A similar analysis may be applied to claims 30 and 31, which recite similar language.

Claims 28-29 and 32-44 inherit the deficiencies of their respective independent claims, and are therefore also rejected.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al (USPN 6,076,734) in view of Luchs (USPN 4,831,526).

As per claims 1-26, Dougherty teaches a method for using a computer system including a sensing device to gather information to determine formatting information (e.g. type of form) and positioning data (i.e. reference point) on an encoded physical medium. (col. 5, lines 22-54; col. 6, lines 11-29; Figure 2). Dougherty further discloses that the computer system identifies parameters relating to the task/application performed (i.e. type of document being generated) (col. 7, lines 57-col. 8, line 10) and provides markings or indicia on the surface of interest to distinguish that surface from other physical media. (col. 5, lines 22-46). Furthermore, the sensing device in the

Dougherty reference measures information within a desired region of interest on a physical surface (with only proximal contact to the desired region of interest). (col. 7, lines 21-32—the sensor can determine “nearness” to a region of interest and thus its position relative to the physical medium/surface.)

Dougherty does not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a method wherein forms relating to insurance services are generated. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses a method in which customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8). At the time of the Applicant’s invention, it would have been obvious to one of ordinary skill in the art to modify the method of Dougherty with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

As per claims 27-44, Dougherty teaches a computer system including a sensing device to gather information to determine formatting information (e.g. type of form) and

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positioning data (i.e. reference point) on a physical medium. (col. 5, lines 22-54; col. 6, lines 11-29; Figure 2). Dougherty further discloses that the computer system identifies parameters relating to the task/application performed (i.e. type of document being generated) (col. 7, lines 57-col. 8, line 10) and provides markings or indicia on the surface of interest to distinguish that surface from other physical media. (col. 5, lines 22-46). Dougherty does not expressly disclose the invention as it relates to printing and identifying information on forms related to specific types of insurance services.

Luchs teaches a system further comprising a printer and forms, wherein the forms relate to insurance services. (Figures 1, 2E-2F; col. 14, lines 46-15; col. 17, line 31-col.18, line 10) Luchs further discloses that customer data, quote information, insurance policy type, deductible, and claim information may be included as parameters on the insurance forms. (Tables in col. 7-8). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system Dougherty with the teaching of Luchs to use a computer system with sensing devices to gather information from forms related to various types of insurance services. One would have been motivated to include these features to provide an automated system which properly positions information on regarding various insurance services into the appropriate forms, thereby minimizing the need for repetitive entry of insurance data for each insurance application (See Luchs: col. 2, lines 6-18) and producing documents that are tailored to an individual client (See Luchs: col. 2, lines 21-25).

***Response to Arguments***

9. Applicant's arguments filed 9/3/04 have been fully considered but they are not persuasive.

The Applicant argues that the Dougherty does not disclose a system in which the pen (i.e. sensing device) knows its position relative to that of the form.

In response, the Examiner disagrees with the Applicant's interpretation of the Dougherty reference. As stated in the rejection above, Dougherty teaches a method for using a computer system including a sensing device to gather information to determine formatting information (e.g. type of form) and positioning data (i.e. reference point) on an encoded physical medium. (col. 5, lines 22-54; col. 6, lines 11-29; Figure 2).

Furthermore, the sensing device in the Dougherty reference measures information within a desired region of interest on a physical surface (with only proximal contact to the desired region of interest). (col. 7, lines 21-32) It is respectfully submitted that the sensor can determine "nearness" to a region of interest, and thus its position relative to the physical medium/surface.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- InsureMarket discloses a web-based method for gathering insurance quotes and information from multiple vendors.



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- Cullen (USPN 6,272,528) teaches a method for gathering insurance data from various vendors using mobile agents.
- Cass (USPN 5,692,073) discloses a method for processing computer-readable forms.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action (additional 112, 2<sup>nd</sup> paragraph rejections). Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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RP

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600